

- 37
12. A method for actively characterizing the latency of an audio channel of a computer, comprising:
- creating at least a first and a second waveform in said audio channel;
  - detecting the presence of the first and second waveform at a point in said audio channel;
  - measuring the time between the detections of the waveforms; and
  - delaying at least one of the waveforms, based at least in part, on the time measured between the detections.

Cancel claim 15.

### REMARKS

The above-referenced patent application has been reviewed in light of the Office Action, dated June 7, 2002, in which: claims 1-10, 12-17, and 19-24 are rejected. Reconsideration of the above-referenced patent application in view of the following remarks is respectfully requested.

Claims 1-10, 12-14, 16-17, and 19-24 are pending in the above-referenced patent application. No claims have been added. Claim 15 has been cancelled because it is identical to claim 14. Therefore, no surrender of subject matter or prosecution history estoppel results from this cancellation. Likewise, claims 1 and 12 are amended, however, this results in no surrender of claim scope or prosecution history estoppel for the reasons explained below.

It is noted that claims identical to claims 1-10 and 12-17 originally in the above-referenced patent application are on appeal to the Board of Patent Appeals and Interferences, because US Patent Application Serial No. 08/882,381, the parent patent application to the above-referenced patent application, has been appealed. This unusual result occurred because the Examiner had indicated that he would allow certain claims of the parent application and a continuation was filed to prosecute the rejected claims, but then, the Examiner changed his mind regarding allowance. Therefore, in order to

restore claims 11 and 18 back into this case, claims 1 and 12 are amended. However, no prosecution history estoppel or change in scope of claims 1-10 and 12-17 results because, as indicated above, claims 1-10 and 12-17 as originally filed are on appeal in the parent application. Furthermore, no narrowing of subject matter occurred since these amendments merely restore claims 11 and 18 as originally filed. Therefore, nothing is relinquished by this amendment.

The Examiner has rejected claims 19 and 22 under 35 USC 103 as being unpatentable over Vahatalo et al. (hereinafter "Vahatalo"). This rejection by the Examiner of these claims is respectfully traversed.

It is noted that the Examiner concedes that Vahatalo does not disclose a machine readable storage medium which executes the method; however, he has not provided a citation to a patent or other prior art documents that provide the missing element of the rejected claims. Nonetheless, Applicants do not rely upon that.

As Applicants indicated in the remarks of the preliminary amendment, Vahatalo does not employ two signal streams to estimate latency. Therefore, one of ordinary skill in the art having Vahatalo before him or her would be unable to produce the claimed subject matter of claims 19 and 22. It is well-established that to make out a *prima facie* rejection under section 103 the Examiner must cite prior art documents that in combination show all the elements and limitations of the rejected claims. Because the Examiner has failed in this regard, his rejection is not proper.

The Examiner has rejected claims 20, 21, 23, and 24 under 35 USC 103 as being unpatentable over Vahatalo et al. (hereinafter "Vahatalo") in view of Hollier. This rejection by the Examiner of these claims is respectfully traversed.

As noted above, the Examiner concedes that the cited documents do not disclose a machine readable storage medium which executes the method; however, Applicants do not rely upon that.

As Applicants indicated in the remarks of the preliminary amendment, Vahatalo does not employ two signal streams to estimate latency. Likewise, Hollier does not cure this deficiency. Therefore, one of ordinary skill in the art having Vahatalo and Hollier before him or her would be unable to produce the claimed subject matter of claims 19 and 22. It is well-established that to make out a *prima facie* rejection under section 103 the Examiner must cite prior art documents that in combination show all the elements and limitations of the rejected claims. Because the Examiner has failed in this regard, his rejection is not proper.

It is therefore respectfully requested that the Examiner withdraw his rejections of claims 19-24.

Claims 1 and 12 are rejected under 35 USC 102(e) on Vahatalo et al. (hereinafter "Vahatalo"). This rejection by the Examiner of these claims is respectfully traversed.

As indicated above, claims 1 and 12 have been amended; however, this amendment is not in response to prior art. Rather, these amendments merely restore claims 11 and 18 in this case and add new claims. Therefore, no claim scope is surrendered and no prosecution history estoppel results from these amendments.

Nonetheless, as indicated in the remarks of the preliminary amendment to the above-referenced patent application, Vahatalo does not anticipate the claims that were originally in the case prior to amendment. Specifically, not all the elements and limitations of claims 1 and 12, prior to amendment, are present in Vahatalo. This is still true after amendment, because the foregoing amendment added limitations, which also are not present in Vahatalo. For example, Vahatalo does not

teach or describe delaying a signal stream or waveform based at least in part the time measured between detections of signal streams or waveforms, as the case may be.

It is therefore respectfully requested that the Examiner withdraw his rejection of claims 1 and 12.

Likewise, the Examiner has rejected claims 2-10 and 13-17 under 35 USC 103. As indicated in the preliminary amendment, the documents cited by the Examiner failed to establish a *prima facie* rejection of these claims; however, as indicated above, these claims have been amended in any event. For example, the documents cited do not teach or describe delaying a signal stream or waveform based at least in part the time measured between detections of signal streams or waveforms, as the case may be. Because the amendment added additional elements not taught or described in the documents cited by the Examiner, these claims patentably distinguish from the cited documents.

It is therefore respectfully requested that the Examiner withdraw his rejection of claims 2-10 and 13-17.

#### CONCLUSION

In view of the foregoing, it is respectfully asserted that all of the claims pending in this patent application are in condition for allowance. If the Examiner has any questions, he is invited to contact the undersigned at (503) 264-0967. Reconsideration of this patent application and early allowance of all the claims is respectfully requested.

Respectfully submitted,

*Howard A. Skaist*

Howard A. Skaist  
Senior Intellectual Property Attorney  
Reg. No. 36,008

Dated:

*10/1/02*

c/o Blakely, Sokoloff, Taylor & Zafman, LLP  
12400 Wilshire Blvd., Seventh Floor  
Los Angeles, CA 90025-1026  
(503) 264-0967

**I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage in an envelope addressed to the Commissioner of Patents, Washington, D.C. 20231 on:**

*October 3, 2002*

**Date of Deposit**

*Angie C. Farr*

**Name of Person Mailing Correspondence**

*Angie C. Farr* *10-3-02*

**Signature**

**Date**

**MARKED VERSION TO SHOW CHANGES**

(amended) 1. A method for actively characterizing the latency of an audio channel of a computer, comprising:

creating at least two signal sample streams for a waveform in the audio channel;  
detecting the presence of the first signal sample stream for said waveform and the second signal sample stream for said waveform at a point in said audio channel; **[and]**  
measuring the time between the detections of the signal sample streams; **and**  
**delaying at least one of the signal sample streams based, at least in part, on the time measured between the detections.**

(amended) 12. A method for actively characterizing the latency of an audio channel of a computer comprising:

creating at least a first and a second waveform in said audio channel;  
detecting the presence of the first and second waveform at a point in said audio channel;  
**[and]**

measuring the time between the detections of the waveforms; **and**

**delaying at least one of the waveforms, based at least in part, on the time measured between the detections.**